

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

David FOELL, and William BJERKE

File No.: 10/531,622
Filed: April 14, 2005
PCT Serial No.: PCT/US03/032467
Filed: October 14, 2003
(14.10.03)

Examiner: M. Safavi

For: INSERT PANEL FOR
CONCRETE FILLABLE
FORMWORK WALL

VIA EFS-WEB
Conf. No. 8430

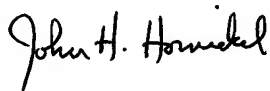
Appeal Brief

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants file their appeal brief from the Office Action, made final, mailed on May 27, 2009. Appellants will have paid the filing fee as a part of the EFS-Web filing process. If any other amount is required, the Office is authorized to charge Deposit Account No. 07-1077.

Respectfully submitted by:



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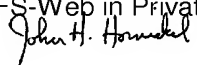
I hereby certify that this paper is being transmitted to the United States Patent and Trademark Office on the date shown below to the EFS-Web in Private PAIR:	
October 23, 2009	Signed 
Date	John H. Hornickel, Reg. No. 29,393

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REAL PARTY IN INTEREST

This application is assigned to PolyOne Corporation, a corporation organized under the laws of the State of Ohio and having its headquarters at 33587 Walker Road, Avon Lake, Ohio 44012.

RELATED APPEALS AND INTERFERENCES

Appellant, his Assignee, and its Legal Representative do not know of any other prior or pending appeals, judicial proceedings or interferences which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims Rejected: 1, 6, and 8

Claims Canceled: 4, 13-18

Claims Allowed: None

Claims Withdrawn: 2, 3, 5, 7, 9, 10-12

Claims Objected To: None

Claims 1, 6, and 8 are on appeal.

STATUS OF AMENDMENTS

No Amendments are pending. An amendment to cancel Claim 6 was filed on July 24, 2009 subsequent to the Final Office Action mailed May 27, 2009. The Office in its Advisory Action refused to enter the amendment. Therefore, Claim 6 remains and is on appeal. The Claims in the Appendix embody this status.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1 concerns an apparatus seen in Fig. 6 and uses the words identified on Page 39 of the specification with respect to the reference numerals and the specification at Page 14, Lines 15 et seq. and the sentence bridging Pages 12 and 13.

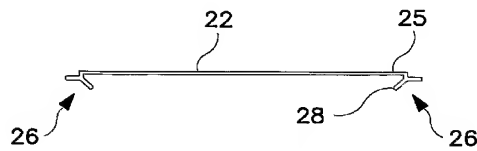


FIG. 6

The apparatus is adapted for engagement with a concrete fillable formwork wall having elongated, octagonal tubular form elements **consisting of:**

a wall panel (22), wherein the wall panel consists of one substantially flat wall (22) and two wall panel ends (25) and a male engagement portion (26) at each end (25), wherein each male engagement portion consists of a fin (28), wherein both fins (28) extend from one side of the wall panel (22), and wherein each fin (28) is adapted to engage a matching female engagement portion (18) on one elongated, octagonal tubular form element (10);

whereby the engagement of the male engagement portions (26) on the wall panel to matching female engagement portions (18) of two elongated, octagonal tubular form elements (10) forms a triangular closed area (24) between the two elongated, octagonal tubular form elements (10) and the wall panel (22), and

whereby the engagement of the wall panel (22) forms a substantially flat exterior wall surface along the elongated, octagonal tubular form elements (10) to which the wall panel is engaged.

Grounds of Rejection to be Reviewed on Appeal

1. Claims 1, 6, and 8 were rejected under §112, First Paragraph.
2. Claims 1, 6, and 8 were rejected under §112, Second Paragraph.
3. Claims 1, 6, and 8 were rejected under § 102(b) using U.S. Pat. No. 6,021,618 (Elderson)

ARGUMENTS

1. **Claims 1, 6, and 8 were rejected under §112, First Paragraph.**

Appellants assert that their Claims satisfy §112, First Paragraph because the specification originally disclosed the text now used in the Claims. The Office has asserted that the specification does not “appear to have originally disclosed an ‘apparatus ...consisting of a wall panel, wherein the wall panel consists of one substantially flat wall and two wall panel ends and a male engagement portion at each end, wherein each male engagement portion consists of a fin, wherein both fins extend from one side of the wall panel’.”

As explained in the Summary of Claimed Subject Matter, Claim 1 is directed to the apparatus appearing in Fig. 6. The phrase quoted from the Office Action above is repeated with the reference numbers found on Page 39 of the specification:

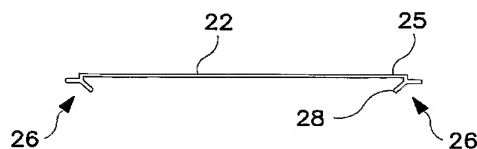


FIG. 6

apparatus ...consisting of a wall panel (22), wherein the wall panel (22) consists of one substantially flat wall (22) and two wall panel ends (25) and a male engagement portion (26) at each end (25), wherein each male engagement portion consists of a fin (28), wherein both fins (28) extend from one side of the wall panel (22)

Page 14, Lines 15 et seq. of the specification provide prose to explain Fig. 6. The fins extending from one side of the wall panel is explained at Page 14, Lines 17-19 and the sentence bridging Pages 12 and 13. The phrase “substantially flat wall” is explained at Page 15, Lines 22 et seq.

A person having ordinary skill in the art (PHOSITA) would readily and completely understand that the language of Claim 1 describes the appearance of Fig. 6 and the specification sentences identified above.

2. Claims 1, 6, and 8 were rejected under §112, Second Paragraph.

Appellants assert that their Claims also satisfy §112, Second Paragraph. The Office had rejected the same claim language for Second Paragraph reasons, referring to an elected species which the Office has previously rejected as unsupported by the specification. Again, the Office must assess what PHOSITA would understand to have been pointed out, not whether each and every word of a Claim is placed like a quotation in the specification. The language of Claim 1 does particularly point out and distinctly claim what appears in Fig. 6, using the terminology of the textual specification, the Listing of Reference Numerals to associate the textual specification with the drawings, and Fig. 6 itself.

With respect to Claim 6, Appellants had attempted to cancel it in its response after final rejection, but the Office refused to enter that amendment in its Advisory Action. Appellants request that the Board cancel Claim 6, *sua sponte*, if it is so inclined.

3. Claims 1, 6, and 8 were rejected under § 102(b) using U.S. Pat. No. 6,021,618 (Elderson)

Appellants are now facing their fifth separate anticipation rejection. Appellants overcame the prior four and now also overcome Elderson, their fifth.

Elderson discloses a metal stud to replace wood studs to form a wall. The metal stud 14 have a pair of L-shape flanges 20 extending perpendicularly from the web 18.

Every word of Claim 1 must be given meaning by the Office; that will certainly happen if a patent claim were to be enforced.

The Office has not given any meaning to “each fin is adapted to engage a matching female engagement portion on one elongated, octagonal tubular form element.”

PHOSITA would read that phrase, go to the specification and drawings and understand that the fin as a type of male engagement portion is configured to mate with a female engagement portion, such as shown in Figs. 7 and 8 and explained in the specification at Page 15, Lines 4 et seq.

The L-shape flanges 20 of Elderson do not anticipate the fins 28 of Applicants’ claims.

Appellants are entitled to have meaning given to their “adapted to” phrase. As stated at MPEP §2111.04,

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “whereby” clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” *Id.* However, the court noted (quoting *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a “whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.” *Id.*

In this application, the “adapted to” phrase states a condition that is material to patentability, explains the purpose of the particular structure of the fins, and completes the concept of the invention that the male engagement portion on the wall panel mate with the female engagement portion on an elongated, octagonal tubular form element.

The “adapted to” phrase is a structural phrase, at least to the extent that whatever structure the female engagement portion might exist on the elongated, octagonal tubular form element, the structure of the fin must be able to engage such structure.

Claim 1 concludes with two paragraphs dedicated to the result of successful engagement: establishment of a triangular closed area between two tubular form elements so engaged and a resulting flat wall surface. Those engagement results are not possible without how the shape of a fin allows engagement with a female engagement

portion. Because there are fins at both ends of the wall panel, a fin at each end allows engagement with two different elongated octagonal tubular form elements because the shape of the male engagement fins mate with the female engagement portions.

Because the “adapted to” phrase is material to patentability and a structural phrase concerning the shape of the fins of the male engagement portions, Claims 1, 6, and 8 are novel over Elderson.

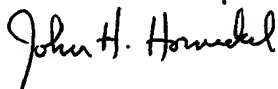
Additional Information

The Board should be aware that the same specification was employed to achieve the grant of U.S. Patent 7,559,176 B2 on July 14, 2009. The Office in this application was kept apprised of the progress of that patent application 10/531,621 to issuance. The issued claims are directed to the elongated octagonal tubular form elements and the combination of those form elements with the wall panel which is the subject of this appeal. The prosecution of this patent application had not reached the point where a rejection for Judge-Made, Obviousness-Type, Double Patenting was considered, at least to Appellants’ knowledge. If such a rejection is made, Appellants and their Assignee are prepared to present a proper Terminal Disclaimer.

Conclusion

Appellants’ Claims 1, 6, and 8 satisfy the requirements of §112 and §102, overcoming the rejections of the Office. Appellants respectfully request the Office to be directed to issue a Notice of Allowance for Claims 1, 6, and 8.

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CLAIMS APPENDIX

1. An apparatus adapted for engagement with a concrete fillable formwork wall having elongated, octagonal tubular form elements consisting of:

a wall panel, wherein the wall panel consists of one substantially flat wall and two wall panel ends and a male engagement portion at each end, wherein each male engagement portion consists of a fin, wherein both fins extend from one side of the wall panel, and wherein each fin is adapted to engage a matching female engagement portion on one elongated, octagonal tubular form element;

whereby the engagement of the male engagement portions on the wall panel to matching female engagement portions of two elongated, octagonal tubular form elements forms a triangular closed area between the two elongated, octagonal tubular form elements and the wall panel, and

whereby the engagement of the wall panel forms a substantially flat exterior wall surface along the elongated, octagonal tubular form elements to which the wall panel is engaged.

6. The apparatus of Claim 1, wherein the wall panel has perforations.

8. The apparatus of Claim 1, wherein the apparatus forms substantially flat walls of a building.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None